

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Douglas Deeds

Serial No.: 10/714,504

Filed: November 13, 2003

For: User Interface Apparatus, and Associated Method, For Facilitating Viewing Of
Display Indication on a User Display by a Visually-Impaired User

Atty. Dkt No.: 004770.00499

Confirmation No. 1052

Group Art Unit: 2174

Examiner: KE, PENG

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT
UNDER 37 CFR 1.181

Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450
Mail Stop Petitions

Dear Sir:

Applicants petition the Director under 37 C.F.R. § 1.181 to withdraw the holding of abandonment of the application referenced above as set forth in the Notice of Abandonment mailed April 5, 2010. Applicants believe no fee is due in connection with this petition. If a fee is due, please charge our Deposit Account No. 19-0733.

Statement of Facts

1. On December 17, 2009, the Board of Patent Appeals and Interferences issued its Decision on Appeal, which decided Applicant's appeal in this matter (Notice of Appeal dated October 19, 2007). In the Decision on Appeal, the Board reversed the rejections to dependent claims 12, 24 and 25.

2. On February 18, 2010, Applicants period for further action (e.g., request reconsideration of the decision, appeal of decision to U.S. Federal Courts, etc.) expired. Applicants did not take any further action.

3. On April 5, 2010, a Notice of Abandonment was mailed. The Notice of Abandonment states the application is allegedly abandoned in view of the Decision on Appeal and because the period for seeking court review of the decision has expired and there are no allowed claims.

4. No other communication was received by Applicant or mailed by the Office between the Decision on Appeal and the Notice of Abandonment. Exhibit 1 is a printout of PAIR's "Transaction History" view for this application.

Point to be Reviewed

The point to be reviewed is whether the holding of abandonment should be withdrawn because the examiner failed to take action after the expiration of the period for further appeal and the condition of the application required the examiner to take action.

Action Requested

Applicant respectfully request that the holding of abandonment of this application be withdrawn. Also, applicant requests the entry of the Amendment filed herewith.

Argument

The Notice of Abandonment appears to have been issued in error. According to 37 C.F.R. 1.197(a): “Jurisdiction over an application or patent under ex parte reexamination proceeding passes to the examiner after a decision by the Board of Patent Appeals and Interferences upon transmittal of the file to the examiner, subject to appellant’s right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the application or patent under ex parte reexamination proceeding may require, to carry into effect the decision of the Board of Patent Appeals and Interferences.” (Emphasis added.)

The condition of the application required examiner action. The Decision on Appeal reversed the rejections of dependent claims 12, 24 and 25. Therefore, with respect to dependent claims 12, 24 and 25, all grounds of rejections were reversed by the Board’s Decision on Appeal.

As stated in MPEP 1214.06(I)(B): “If the Board or court affirms a rejection against an independent claim and reverses all rejections against a claim dependent thereon, after expiration of the period for further appeal, the examiner should proceed in one of two ways: (1) Convert the dependent claim into independent form by examiner’s amendment, cancel all claims in which the rejection was affirmed, and issue the application; or (2) Set a 1-month time limit in which appellant may rewrite the dependent claim(s) in independent form. Extensions of time under 37 C.F.R. 1.136(a) will not be permitted. If no timely reply is received, the examiner will cancel all rejected and objected to claims and issue the application with the allowed claims only.” The Examiner did neither.

Upon expiration of Applicant’s period for further action, the Examiner failed to proceed in either of these two ways, and, indeed, failed to take any action before issuing the Notice of Abandonment, which mailed on April 5, 2010. Thus, the notice of abandonment was in error.

Additionally, in the interests of furthering prosecution, Applicant files herewith an Amendment following the Decision on Appeal, placing this case in condition for allowance based on the Board's Decision in this case.

CONCLUSION

In summary, the subject patent application was held abandoned because the examiner failed to take action as condition of the application required from the Board's Decision on Appeal. In view of the above stated facts, the Commissioner is hereby requested to withdraw the holding of abandonment and enter the Amendment filed herewith.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date: April 30, 2010

By: /Evan M. Clark/

Evan M. Clark

Registration No. 64,836

1100 13th Street, N.W., Suite 1200
Washington, DC 20005
Telephone: 202-824-3000

10/714,504	User interface apparatus, and associated method, for facilitating viewing of display indicia on a user display by a visually-impaired user	04-21-2010::10:53:55
Transaction History		
Date	Transaction Description	
04-05-2010	Mailing of Abandonment after Board of Appeals	
04-02-2010	Abandonment after Board of Appeals	
12-18-2009	Mail BPAI Decision on Appeal - Affirmed in Part	
12-17-2009	BPAI Decision - Examiner Affirmed in Part	
12-02-2009	Waiver of Hearing by Appellant	
10-23-2009	Notification of Appeal Hearing	
10-23-2009	Notification of Appeal Hearing	
03-13-2009	Docketing Notice Mailed to Appellant	
03-12-2009	Assignment of Appeal Number	
12-16-2008	Appeal Awaiting BPAI Docketing	
09-04-2008	Mail Reply Brief Noted by Examiner	
09-02-2008	Reply Brief Noted by Examiner	
07-10-2008	Request for Oral Hearing	
07-11-2008	Date Forwarded to Examiner	
07-10-2008	Reply Brief Filed	
05-14-2008	Exam. Ans. Review Complete	
05-13-2008	Mail Examiner's Answer	
05-12-2008	Examiner's Answer to Appeal Brief	
03-03-2008	Appeal Brief Review Complete	
03-03-2008	Date Forwarded to Examiner	
02-19-2008	Appeal Brief Filed	
01-28-2008	Notice -- Defective Appeal Brief	
01-22-2008	Appeal Brief Review Complete	
01-22-2008	Date Forwarded to Examiner	
12-19-2007	Defective / Incomplete Appeal Brief Filed	
12-19-2007	Appeal Brief Filed	
10-19-2007	Notice of Appeal Filed	
10-19-2007	Request for Extension of Time - Granted	
09-12-2007	Mail Advisory Action (PTOL - 303)	
09-11-2007	Advisory Action (PTOL-303)	
08-23-2007	Date Forwarded to Examiner	
08-21-2007	Amendment after Final Rejection	
08-21-2007	Request for Extension of Time - Granted	
04-19-2007	Mail Final Rejection (PTOL - 326)	
04-16-2007	Final Rejection	
02-09-2007	Date Forwarded to Examiner	
01-31-2007	Response after Non-Final Action	
10-31-2006	Mail Non-Final Rejection	
10-30-2006	Non-Final Rejection	
02-27-2006	Information Disclosure Statement considered	
04-25-2006	Information Disclosure Statement considered	
04-25-2006	Information Disclosure Statement (IDS) Filed	

04-25-2006	Information Disclosure Statement (IDS) Filed
04-25-2006	Reference capture on IDS
03-03-2006	Correspondence Address Change
03-03-2006	Change in Power of Attorney (May Include Associate POA)
02-27-2006	Information Disclosure Statement (IDS) Filed
02-27-2006	Information Disclosure Statement (IDS) Filed
02-27-2006	Reference capture on IDS
09-20-2005	Case Docketed to Examiner in GAU
02-02-2005	IFW TSS Processing by Tech Center Complete
02-02-2005	Case Docketed to Examiner in GAU
04-22-2004	Application Return from OIPE
04-22-2004	Application Return TO OIPE
04-22-2004	Application Dispatched from OIPE
04-23-2004	Application Is Now Complete
04-09-2004	Payment of additional filing fee/Preexam
04-09-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic
11-13-2003	Claim Preliminary Amendment
02-17-2004	Notice Mailed--Application Incomplete--Filing Date Assigned
02-01-2004	Cleared by OIPE CSR
12-14-2003	IFW Scan & PACR Auto Security Review
11-13-2003	Initial Exam Team nn

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